

III. REMARKS

Claims 1-55 are pending in this application. Applicants do not acquiesce in the correctness of the objections and rejections and reserve the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

In the Final Office Action, the Office rejects claims 1-9, 11-21, 23-33, 35-47, and 49-55 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,848,396 (Gerace) in view of U.S. Patent No. 6,078,916 (Culliss). Since the combination, if proper, of Gerace and Culliss fails to teach or suggest each and every feature of the claimed invention as required by 35 U.S.C. § 103(a), Applicants respectfully request withdrawal of this rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Applicants respectfully submit that the Gerace and Culliss references, taken alone or in combination, fail to meet each of the three basic criteria required to establish a *prima facie* case of obviousness. As such, the rejection under 35 U.S.C. § 103(a) is defective.

For example, with respect to claims 1, 13, 25 and 39, Applicants again submit that Gerace fails to teach or suggest, *inter alia*, the claimed marketing page element placed anywhere on the web page, said marketing page element providing storage for data items having marketing content for a marketed item, wherein the data items are for displaying on the web page. In

response to Applicants previous arguments with respect to this claimed feature, the Office states that "...while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to." However, Applicants submit that this statement is incorrect, in that it shifts the burden of proof from the Office to Applicants. Specifically, rather than responding to Applicants arguments against the specific portions of the references that the Office claims teach each and every feature of the claimed invention, the Office appears to be requiring Applicants to respond to portions of the reference not specified by the Office that the Office might equate with features of the claimed invention. Applicants interpret this requirement as mandating that they provide a discussion with respect to each and every feature, whether discussed by the Office or not, of the cited references that details why Applicants believe they do not teach or suggest the claimed invention. To this extent, Applicants submit that the Office's statement imposes an unduly burdensome requirement on Applicants. Accordingly, Applicants respectfully request that the Office provide the specific sections of the cited references that it contends teach or suggest the features of the claimed invention.

The Office further states that "...in response to Applicants' arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are base on combinations of references." Applicants assert that this statement again attempts to shift the burden of proof to Applicants. Specifically, the Office appears to be requiring that Applicants not only respond to the specific reference cited with respect to a particular feature of the claimed invention, but instead to prove why the feature is not covered by any other references. As argued above, this places an undue burden on Applicants.

To this extent, the Office fails to respond to the substance of alternative arguments previously presented by the Applicants. Accordingly, Applicants respectfully request that the Office consider and respond to the arguments herein presented with regard to the portions of the references cited by the Office in support of its rejections.

In particular, Applicants submit that Gerace fails to teach a marketing page element placed on the web page, the marketing page element providing storage for data items having marketing content for a marketed item, wherein the data items are for displaying on the web page. In the Final Office Action, the Office equates the marketing page element of the claimed invention with the ad module of Gerace as shown in FIG. 2. In doing so, it appears that the Office equates web server 27 of FIG. 2 with a web page. However, FIG. 2, does not show a web page, but instead a program 31, which includes advertisement module 75. See col. 4, lines 36-40. To this extent, FIG. 2 does not teach that advertisement module 75 is an element (hence the name marketing page *element*) of the web page that is placed on the web page. In further support of its argument, the Office cites a portion of Gerace, which teaches

With respect to the advertisement module 75, program controller 79 obtains sponsor submitted advertisements from module 75 and generates a screen view formatted according to user preferences as determined from the psychographic profile in the user profiling member 73. That is, program controller 79 enables display of advertisements customized to the user, as to content and presentation...Program controller 79 obtains the content from the advertisement module 75 and the presentation details for the subject user from the user profiling member 73.

However, here again the passage of Gerace cited by the Office does not teach or suggest that the advertisement module is an element of the web page that is placed on the web page.

The Office further, in the alternative, equates the marketing page element of the claimed invention with a Page Display of Gerace, which the Office states "...has certain areas designated

for displaying marketing content...[which] can be considered as items.” Final Office Action, page 15, par. 1. In support, the Office cites a passage of Gerace that describes the set of Page Display Objects. Final Office Action, page 15, par. 3; citing Gerace, col. 7, lines 23-37. However, the passage of Gerace cited by the Office does not refer to a Page Display, but only Page Display Objects. Furthermore, the Page Display Objects in the passage of Gerace cited by the Office only teach that “...the set of Page Display Objects 35a-35c defines the screen views transmitted and displayed to end users,” and does not specify that they are elements of the web page that are placed on the web page. Col. 7, lines 23-25. Conversely, Gerace shows its set of Page Display Objects as a part, not of a web page, but instead as part of main routine 39 of program 31 that “...functions similarly to program controller 79 of FIG. 2.” Col. 5, lines 59-61; FIG. 3. To this extent, the Office has not established that Gerace teaches a marketing page element placed on the web page, the marketing page element providing storage for data items having marketing content for a marketed item, wherein the data items are for displaying on the web page.

The Office further complains that Applicants have employed the phrase “discrete element” in its arguments, stating that “limitations from the specification are not read into the claims,” and that “...the terms ‘discrete element’ do not appear in the Applicants’ independent claim 1.” Final Office Action, page 14, pars. 1 and 4. In response, Applicants assert that the limitation marketing page element placed on the web page in claim 1 indicates the marketing page *element* is an element of the web page. Furthermore, an element of a web page that is located on a web page is by definition discrete because a web page is, in and of itself, a finite

entity. Accordingly, Applicants herein incorporate its arguments from the previous Office Action responses.

In contrast to Gerace in general, and the cited portions of Gerace in particular, the claimed invention includes, for example, "a marketing page element placed anywhere on the web page, said marketing page element providing storage for data items having marketing content for a marketed item, wherein the data items are for displaying on the web page." Claim 1. As such, the data items as included in the claimed invention have marketing content and are for displaying on a web page. Furthermore, the data items are stored in a marketing page element that is placed anywhere on the web page. The unique placement of the marketing page element on the web page, among other things, allows for the effective separation of tasks relating to the design of the web page and those relating to the design of a means for implementing a marketing strategy to determine what marketing content should be presented on that web page. This is in sharp contrast with the cited portions of Gerace, in which the various features are not taught to be stored in a discrete element of the web page that is placed on the web page, to include data items to be displayed on the web page, or to have marketing content. Thus, the cited passages in Gerace do not teach a marketing page element as included in the present invention. As a result, Applicants respectfully request withdrawal of the rejection of claims 1, 13, 25 and 39, and each of the corresponding rejected dependent claims, as allegedly being unpatentable over Gerace in view of Culliss in view of Dabney.

With further respect to claims 1, 13, 25 and 39, Applicants submit that, as argued previously, Gerace fails to teach or suggest that the data items correspond to a marketed item. In the Final Office Action, the Office responds to Applicants' arguments by stating that "[a]n

advertisement that results in a purchase is equivalent to presenting data items related to a marketed item such as a product or coupon.” Final Office Action, page 18, final par. In support, the Office cites a passage of Gerace that states

In accordance with another aspect of the present invention, there is a module (e.g., advertisement module) that records history of users viewing the advertisements. For each advertisement, the module records (i) number of times viewed by a user, (ii) number of times selected for further information by a user, and/or iii) number of purchases initiated from display of the advertisement to a user.” Col. 2, lines 35-42.

However, Applicants assert that the passage of Gerace cited by the Office teaches only the recording of history of users viewing the advertisements and actions taken therefrom, and still does not teach or suggest that the data items correspond to a marketed item. A marketed item can comprise, for example, a product or a coupon (see, e.g., page 14, lines 3-4 of the specification). This feature of the claimed invention is clearly not shown or suggested by Gerace. In particular, to the extent, if any, that Gerace discloses marketing content, it is limited to advertising banners. Further, the combination of Gerace with Culliss, if proper, fails to rectify this deficiency. As a result, Applicants again respectfully request withdrawal of the rejection of claims 1, 13, 25 and 39, and each of the corresponding rejected dependent claims, as allegedly being unpatentable over Gerace in view of Culliss in view of Dabney.

With respect to claims 4, 16, 28 and 42, Applicants respectfully submit that Gerace also fails to teach that the marketing strategy is specified by a business rule in an if - then (action) format. Instead, Gerace teaches an Ad Series Object that provides an indication of the demographic group pre-requested by the sponsor to be shown that advertisement. Col. 12, lines 22-27. However, nowhere does Gerace specify that the indication of demographic group is in an if - then (action) format. The present invention, in contrast, includes “...wherein said marketing

strategy is specified by a business rule in an if - then (action) format.” Claim 4. As such, the format of the marketing strategy is not unspecified as is the indication of the demographic group in Gerace, but rather has marketing rules in a if – then (action) format. For the above reasons, the indication of the demographic group in Gerace is not equivalent to the marketing strategy as included in the claimed invention. Accordingly, Applicants request that the rejection be withdrawn.

Further, the Office rejects claims 10, 22, 34, and 48 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Gerace in view of Culliss in view of Dabney in view of U.S. Patent No. 6,342,907 (Petty). Applicants note that the Office relies on its interpretation of Gerace in view of Culliss in view of Dabney with respect to the corresponding independent claim for each of these claims. To this extent, Applicants herein incorporate the arguments presented above with respect to claims 1, 13, 25 and 39, and respectfully request withdrawal of the rejection of claims 10, 22, 34, and 48 as allegedly being unpatentable over Gerace in view of Culliss in view of Dabney in view of Petty.

Applicants submit that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicants do not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter.

Additionally, Applicants do not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicants reserve the right to present such arguments in a later response should one be necessary.

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

Respectfully submitted,

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